



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,279	09/12/2003	Chen Chien Lo	110466-152117	7620
31817 7590 04/10/2008 SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 S.W. FIFTH AVE. PORTLAND, OR 97204				
EXAMINER				
LEE, PHILIP C				
ART UNIT		PAPER NUMBER		
2152				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,279

Applicant(s)

LO ET AL.

Examiner

PHILIP C. LEE

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-9, 15, 16 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-9, 15, 16 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 2152

1. This action is responsive to the amendment and remarks filed on January 9, 2008.
2. Claims 1-2, 5-9, 15-16 and 22-24 are presented for examination and claims 3-4, 10-14 and 17-21 are canceled.
3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Objection

4. Claims 1-2, 5-9, 15-16 and 22-24 are objected to because of the following informalities: Claims 1, (lines 10-11), 15 (line 11), 22 (line 7), “the first and second locations” should have been “the first location and the second location”; Claim 5 (lines 3 and 5), “the first and second instant messaging clients” should have been “the first instant message client and the second instant message client”; Claim 16 (line 1), “programming instructions” should have been “the plurality of programming instructions”.

Claim Rejections – 35 USC 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2152

6. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack proper antecedent basis:

i. the relative position of the second location – claim 8.

Claim Rejections – 35 USC 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 5-9, 15, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene, U.S. Patent 6,668,173 (hereinafter Greene) in view of Mayer, U.S. Patent Application Publication 2004/0122810 (hereinafter Mayer).

9. Greene and Mayer were cited in the previous office action.

10. As per claim 1, Greene teaches the invention substantially as claimed comprising: first receiving, by a first instant messaging client, a first location of the first instant messaging client (col. 3, lines 42-56); and

Art Unit: 2152

second receiving, by a first instant messaging client, from an instant messaging server a second location of a second instant messaging client (col. 4, lines 13-16).

11. Greene does not teach determining a proximity of the first and second locations. Mayer teaches determining, by a first instant messaging client, a proximity of the first and second locations (i.e., determining, by a wireless device (e.g., cell phone) in a network, using GPS (first and second GPS locations) that potential dates are close to a user of the wireless device) ([0073]); and automatically executing an application program (executing an application program to mark a conspicuous sign) , by the first instant messaging client, if the proximity meets a pre-determined threshold ([0073])(Noted that it is inherent a predetermined threshold must be met in order for the application program to determine when to mark the conspicuous sign in the contactee list).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Mayer because Mayer's teaching of determining a proximity would increase the user alertness in Greene's system by providing a notification in order to let a user know that other users are in proximity.

13. As per claim 15, Greene teaches the invention substantially as claimed comprising:

a storage medium (inherently comprised in 11, 13 of fig. 1); and

a plurality of programming instructions stored on the storage medium (inherently comprised in 11, 13 of fig. 1) and configured to enable a first instant messaging client to
first receive a first location of the first instant messaging client (col. 3, lines 42-56); and
second receive from an instant messaging server a second location of a second instant messaging client (col. 4, lines 13-16).

14. Greene does not teach determining a proximity of the first and second locations. Mayer teaches determine a proximity of the first and second locations (i.e., determining by a wireless device (e.g., cell phone) in a network, using GPS (first and second GPS locations) that potential dates are close to a user of the wireless device ([0073]); and automatically executing an application program (executing an application program to mark a conspicuous sign) if the proximity meets a pre-determined threshold ([0073])(Noted that it is inherent a predetermined threshold must be met in order for the application program to determine when to mark the conspicuous sign in the contactee list).

15. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Mayer because Mayer's teaching of determining a proximity would increase the user alertness in Greene's system by providing a notification in order to let a user know that other users are in proximity.

Art Unit: 2152

16. As per claim 22, Greene teaches the invention substantially as claimed comprising:

a processor (inherently comprised in 11, 13 of fig. 1); and
logic to be operated by the processor (inherently comprised in 11, 13 of fig. 1) to
first receive a first location of the first instant messaging client (col. 3, lines 42-56); and
second receive from an instant messaging server a second location of a second instant messaging client (col. 4, lines 13-16).

17. Greene does not teach determining a proximity of the first and second locations. Mayer teaches determine a proximity of the first and second locations (i.e., determining, by a wireless device (e.g., cell phone) in a network, using GPS (first and second GPS locations) that potential dates are close to a user of the wireless device ([0073]); and automatically executing an application program (executing an application program to mark a conspicuous sign) if the proximity meets a pre-determined threshold ([0073])(Noted that it is inherent a predetermined threshold must be met in order for the application program to determine when to mark the conspicuous sign in the contactee list).

18. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Mayer because Mayer's teaching of determining a proximity would increase the user alertness in Greene's system by providing a notification in order to let a user know that other users are in proximity.

19. As per claim 5, Greene and Mayer teach the invention substantially as claimed in claim 1 above. Mayer further teach comprising: displaying, by the first instant messaging client, an initial icon indicating an initial status of the first and second instant messaging clients ([0073]) (e.g., a conspicuous sign or a score); and displaying, by the first instant messaging client, a revised icon corresponding to location changes of the first and second instant messaging clients ([0073]) (e.g., a more emphasized mark or an increase score).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Mayer for the same reason set forth in claim 1 above.

21. As per claim 6, Greene and Mayer teach the invention substantially as claimed in claim 5 above. Greene further teach wherein the initial icon is a selected one of: an offline indicator, an online indicator, and an emoticon (col. 1, lines 26-27).

22. As per claim 7, Greene and Mayer teach the invention substantially as claimed in claim 5 above. Greene further teach wherein the revised icon is a selected one of: a country identifier, a state identifier, a government seal, a flag, a building identifier, and a user identifier (col. 4, line 47-col. 5, line 14).

23. As per claim 8, Greene and Mayer teach the invention substantially as claimed in claim 5 above. Mayer further teach a proximity map including a marker identifying the

relative position of the second location to the first location when the second location is proximate to the first location ([0073]).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene and Mayer for the same reason set forth in claim 5 above.

25. As per claim 9, Greene and Mayer teach the invention substantially as claimed in claim 8 above. Greene further teach wherein the marker is a selected one of: a country identifier, a state identifier, a government seal, a flag, a building identifier, and a user identifier (col. 4, line 47-col. 5, line 14).

26. As per claim 24, Greene and Mayer teach the invention substantially as claimed in claim 8 above. Greene further teach wherein the first instant messaging client is associated with a category (e.g., associated with a class of location tags), and a level of detail associated with the received second location provided by the instant messaging server is based at least in part on the category (detail associated with the status update message provided by the IM server is based at least in part on the associated class of location tags) (col. 4, lines 2-16).

27. Claims 2, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene and Mayer in view of O'Neil, U.S. Patent Application Publication 2002/0107027 (hereinafter O'Neil).

28. O'Neil was cited in the previous office action.

29. As per claims 2, 16 and 23 Greene and Mayer teach the invention substantially as claimed in claims 1, 15 and 22 above. Although Greene teaches transmitting, by the first instant messaging client, to the instant messaging server the first location (col. 4, lines 13-14), however, Greene and Mayer do not teach receiving advertisement responsive to location. O'Neil teaches receiving, by a first client, an advertisement from a server, the advertisement having been determined for the first client based on the first location ([0004], [0027]-[0029]).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Greene, Mayer and O'Neil because O'Neil's teaching of receiving advertisement determined based on client location would increase the functionality of Greene's and Mayer's systems by providing targeted content such as advertisement to users based on location information such as timing information, consumer demographics, specific consumer instructions or any other information that will increase the likelihood of a successful match ([0028]).

31. Applicant's arguments with respect to claims 1-2, 5-9, 15-16 and 22-24, filed 01/09/08, have been fully considered but they are moot in view of new ground(s) of rejection.

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

Art Unit: 2152

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

P.L.

/Bunjod Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152